APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/457,842	SAWADA ET AL.
		Examiner	Art Unit
		Cristina Owen Sherr	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-19</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-19</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   Claims 1 – 19 were examined.

Information Disclosure Statement

2.   An information disclosure statement was filed with this application. The English

abstracts of the references provided in Japanese language have been considered.

Those references provided in Japanese language with no English abstract have not

been considered.

Specification

3.   The specification has not been checked to the extent necessary to determine the

presence of all possible minor errors. Applicant's cooperation is requested in correcting

any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed
publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States
before the invention by the applicant for patent, except that an international application filed under the
treaty defined in section 351(a) shall have the effect under this subsection of a national application
published under section 122(b) only if the international application designating the United States was
published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the
invention by the applicant for patent, except that a patent shall not be deemed filed in the United
States for the purposes of this subsection based on the filing of an international application filed under
the treaty defined in section 351(a).

5.   Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Akiyama et al

(US 5,737,415A).

6.   Akiyama teaches a data charging system comprising a content generator for

generating contents containing object data, a recording medium for recording the

charging data used for charging f or said object data and the recognition data used for

recognition of the object data, and a data charging apparatus for charging for the use of

said object data by using said charging data and said recognition data recorded;

wherein said data charging apparatus comprises data reading logic for reading said

recognition data and said charging data from said recording medium, a separator for

separating said object data from said contents, an recognition logic for recognizing said

separated object data by using said recognition data read out, an accounting logic for

charging for the use of said recognized object data by using said charging data read

out, and a writing logic for writing, as said charging data, the results of charging for the

use of said recognized object data into said recording medium (Col. 8 In 15 – Col. 9 In

35).

7.   Claim 2 is rejected under 35 U.S.C. 102(a) as being anticipated by Saito (US

6,002,772A).

8.   Saito discloses a content generator for embedding digital watermarks in object

data and generating contents in a data charging system which records, on a recording

medium, the charging data used for charging for object data contained in said contents

and the recognition data used for recognizing the object data and charges only for the

use of the object data embedded with said digital watermarks by using said charging

data and said recognition data recorded. (Col. 5, ln 35-50).

9.   Claims 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Akiyama

et al (US 5,737,415A).

10.   Akiyama teaches a data charging system which records, on a recording medium,

the charging data used for charging for object data contained in said contents and the

recognition data used for recognizing the object data and charges for the use of said

object data by using said charging data and said recognition data recorded, a data

charging apparatus comprising a data reading logic for reading said recognition data

and said charging data from said recording medium, a separator for separating said

object data from said contents, a recognition logic for recognizing said separated object

data by using said recognition data read out, an accounting logic for charging for the

use of said recognized object data by using said charging data read out, and a writing

logic for writing, as said charging data, the results of charging for the use of said

recognized object data into said recording medium. wherein said contents comprise

said object data and said recognition data for recognizing this object data, said

separator separates said object data and said recognition data from said contents, said

recognition logic recognizes said object data, based on said recognition data separated

from said contents and on said recognition data read out from said recording medium,

and said accounting logic charges for said object data by using said charging data read

out. (Col. 8 ln 15 – Col. 9 ln 35); further comprising a watermarking logic for embedding

digital watermarks in said object data separated from said contents, wherein said

separator separates said recognition data from said contents, said recognition logic

recognizes said object data, based on said recognition data separated from said

contents and on said recognition data read out from said recording medium, and said

accounting logic charges for said object data embedded with said digital watermarks

(Col. 8 In 15 – Col. 9 In 35); wherein a digital watermark is embedded in said object data

in said contents, said data charging apparatus further comprising a means for detecting

if said object data is embedded with said digital watermark, said separator separating

said object data and said recognition data from said contents, said recognition logic

recognizing said object data, based on said recognition data separated from said

contents and on said recognition data read out from said recording medium, and said

accounting logic charging for said object data only if said object data is found to be

embedded with said digital watermark (Col. 8 In 15 – Col. 9 In 35); wherein said

charging data recorded on said recording medium contains at least payment data which

indicates the payment made in advance for the use of said object data, and said

accounting logic charges for the use of said object data within the limits of the amount

indicated by said payment data contained in said charging data (Col. 8 In 15 – Col. 9 In

35); wherein said charging data recorded on said recording medium further contains

unit price data representing the accounting unit for the use of said object data and the

price corresponding to the accounting unit, said data charging apparatus comprising an

accounting unit detection logic for detecting unit accounting amount data which

represents the amount of said accounting unit for the object data separated from said

contents, said accounting logic charging within the limits of the amount indicated by said

payment data, based on said unit price data contained in said charging data read out

and on the unit accounting amount data detected (Col. 8 ln 15 – Col. 9 ln 35); wherein

said charging data recorded on said recording medium further contains unit price data

representing the accounting unit for the use of said object data and the price

corresponding to the accounting unit as well as accounting range data which represents

the range of one billing, said data charging apparatus comprising an accounting unit

detection logic for detecting unit accounting amount data which represents the amount

of said accounting unit for the object data separated from said contents, wherein said

accounting logic charging each time within the limits of the amount indicated by said

payment data, based on said unit price data contained in said charging data read out

and on the unit accounting amount data detected (Col. 8 ln 15 – Col. 9 ln 35).

11.   Claims 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by

Akiyama et al (US 5,737,415A).

12.   Akiyama teaches a data charging method for generating contents which contain

object data and recognition data used for the recognition of this object data, recording

the charging data used for charging for said object data and the recognition data used

for recognition of the object data, and charging for the use of said object data by using

said charging data and said recognition data recorded, comprising the steps of reading

said recognition data and said charging data from said recording medium, separating

said object data from said contents, recognizing said separated object data by using

said recognition data read out, charging for the use of said recognized object data by

using said charging data read out; and writing, as said charging data, the results of

charging for the use of said recognized object data into said recording medium (Col. 8 ln
15 – Col. 9 ln 35); wherein said object data in said contents are embedded with digital
watermarks, comprising the steps of separating said object data and said recognition
data from said contents; recognizing said object data, based on said recognition data
separated from said contents and on said recognition data read out from said recording
medium; detecting said digital watermark embedded in said object data; and charging
for said recognized object data only by using said charging data read out if said object
data is found to be embedded with said digital watermark (Col. 8 ln 15 – Col. 9 ln 35);
further comprising the steps of separating said object data and said recognition data
from said contents; recognizing said object data, based on said recognition data
separated from said contents and on said recognition data read out from said recording
medium; embedding digital watermarks in said separated object data; and charging for
the use of the object data embedded with said digital watermarks by using said
charging data read out (Col. 8 ln 15 – Col. 9 ln 35).

13.   Claims 13-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Saito
(US 6,002,772A).

14.   Saito teaches a data charging apparatus of a data charging system which
records, on a recording medium, the charging data used for charging for the object data
contained in contents and the recognition data used for recognition of the object data,
and charges for the use of said object data by using said charging data and said
recognition data recorded; a computer program product enabling a computer to execute
the steps of reading said recognition data and said charging data from the recording

medium,   separating said object data from said contents, recognizing said separated

object data by using said recognition data read out, charging for the use of said

recognized object data by using said charging data read out, and writing, as said

charging data, the results of charging for the use of said recognized object data into

said recording medium. (Col. 5, In 35-50). Saito further teaches a computer program

product according to Claim 13, above, wherein said contents contain said object data

and said recognition data used for recognition of the object data, said object data and

said recognition data are separated from said contents in said separation step, said

object data is recognized in said recognition step, based on said recognition data

separated from said contents and on said recognition data read out from the recording

medium, and a charge is made for said object data in said charging step by using said

charging data read out (Col. 5, In 35-50); wherein the computer is made to execute the

step of embedding digital watermarks in said object data separated from said contents,

said object data and said recognition data are separated from said contents in said

separation step, said object data is recognized in said recognition step, based on said

recognition data separated from said contents and on said recognition data read out

from the recording medium, and a charge is made for said object data embedded with

said digital watermarks in said charging step (Col. 5, In 35-50); wherein said object data

in said contents are embedded with digital watermarks, the computer is further made to

execute the step of detecting that said object data is embedded with said digital

watermarks, said object data and said recognition data are separated from said

contents in said separation step, said object data is recognized in said recognition step,

based on said recognition data separated from said contents and on said recognition

data read out from the recording medium, and a charge is made for said object data in

said charging step only if said object data is found to be embedded with said digital

watermark (Col. 5, In 35-50); wherein said charging data recorded on said recording

medium contains at least payment data which indicates the payment made in advance

for the use of said   object data, and prices are charged in said charging step for the

use of said object data within the limits of the amount indicated by said payment data

contained in said charging data (Col. 5, In 35-50); wherein said charging data recorded

on said recording medium further contains unit price data presenting the accounting unit

for the use of said object data and the price corresponding to the accounting unit, and a

computer is made to execute the step of detecting unit accounting amount data which

represents the amount of said accounting unit for the object data separated from said

contents, and prices are charged for the use of said object data within the limits of the

amount indicated by said payment data, based on said unit price data contained in said

charging data read out and on the unit accounting amount data detected in said

charging step (Col. 5, In 35-50); wherein said charging data recorded on said recording

medium further contains unit price data representing the accounting unit for the use of

said object data and the price corresponding to the accounting unit as well as

accounting range data which represents the range of one billing, and a computer is

made to execute the step of detecting unit accounting amount data which represents

the amount of said accounting unit for the object data separated from said contents, and

a price is charged each time for the use of said object data within the limits of the

amount indicated by said payment data, based on said unit price data contained in said

charging data read out and on the unit accounting amount data detected (Col. 5, In 35-
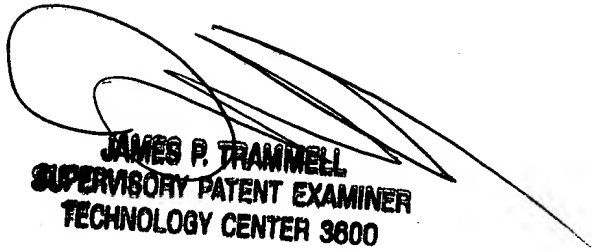
50).

Conclusion

15.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

16.   Saito et al at US 5,848,158A discloses a data copyright management system.

17.   Saito et al at US 6,343,283B1 discloses a data copyright management system.

18.   Saito et al at US 6,081,794A discloses a data copyright management system.

19.   Saito et al at US 6,076,077A discloses a data management system.

20.   Downs et al at US 6,226,618B1 discloses an electronic content delivery system.

Contact Information

21.   Any inquiry concerning this communication from the Examiner should be directed

to Cristina Owen Sherr, whose telephone number is (703) 305-0625. The Examiner can

normally be reached on Mondays through Fridays from 8:30 AM – 5:00 PM.

22.   If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, James Trammell, can be reached at (703) 305-9768. The FAX phone

number for this group is (703) 305-7687.

23.   Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the group receptionist, whose telephone number is

(703) 305-3900.

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